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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/589,626
Filing Date: June 07, 2000
Appellant: SCHACHAR, RONALD A.

William A. Munck
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 23, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8) with respect to "Group B" and "Group C" and the grounds of rejection under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-21 are rejected under 35 U.S.C. § 101. This rejection is set forth in prior Office Action, Paper No. 14.

Claims 1-7 and 12-17 are rejected under 35 U.S.C. § 102(b). This rejection is set forth in prior Office Action, Paper No. 14.

Claims 8-11 and 18-21 are rejected under 35 U.S.C. § 103(a). This rejection is set forth in prior Office Action, Paper No. 14.

(11) Response to Argument

In regard to the rejection under 35 U.S.C. § 101, since scleral contact (e.g., claim 1, line 1) and scleral expansion (e.g., claim 1, line 2) are positively recited, the sclera itself is positively recited in combination with the prosthesis. The Appellant has opted not to use the claim language suggested by the examiner (Paper No. 10: page 2, lines 9-11) for overcoming this rejection. (Attached is a copy of the pertinent notice, to which MPEP 2105 refers, signed by Commissioner Donald J. Quigg on April 7, 1987, and published at 1077 O.G. 24 on April 21, 1987.)

In regard to the rejection under 35 U.S.C. § 102(b) based upon Schachar, US 5,354,331, it is first noted that the term “elongated” (e.g., page 10, line 3, of the Appellant’s Brief) does not appear anywhere in the Appellant’s claims 1-21, nor is there any claim limitation that the ends be free or unattached. The examiner disagrees with the Appellant’s assertion that in the Schachar patent, “[t]he ‘overlapping ends’ cease to exist after the scleral expansion band has been formed” (page 11, lines 8-9, of the Appellant’s Brief), especially since the overlapping ends play a role in

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facilitating circumferential adjustments of the (previously formed) scleral expansion band of Schachar (US 5,354,331: column 7, lines 4-12). Moreover, under an alternative interpretation, *each* of the “plurality of parts” (US 5,354,331: column 7, line 2) or *the* “strip of material” (US 5,354,331: column 7, line 5) is a body comprising first and second ends, a planform that expands the contacted sclera (US 5,354,331: column 7, lines 36-42), and other features set forth in the claims. Attention is directed to page 3, lines 12-17, of Paper No. 14.

In regard to the rejection under 35 U.S.C. § 103(a) based upon Schachar, US 5,354,331, if the cross-sectional dimensions of the Schachar band slidable ends were not modified, then the resulting bulge would create an unwanted asymmetry in the effective working distance of the ciliary muscle and would even hinder *in situ* circumferential adjustments. Although ends of reduced thickness or height and with relatively flat sliding surfaces may be an improvement, the absence of guiding structure has the potential of imposing tissue trauma at the end edges and would unduly burden the screw mechanism with shear stresses and the like. Complementary concave and convex (e.g., groove and ridge) tracking surfaces that maintain generally uniform band cross-sections would alleviate these problems and would provide smooth guiding surfaces for relative movement of the slidable ends via the tangential screw mechanism. Since complementary concave and convex tracking surfaces appear to be the only viable means for providing the adjustable overlap and since the level of ordinary skill is quite high in this particular art, such would have been obvious, if not inherent, for the adjustable embodiments presented at column 7, lines 4-12, of Schachar.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Dave Willse

Primary Examiner

Art Unit 3738

March 1, 2004

Conferees

Angela Sykes

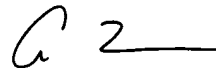
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Animals - Patentability

A decision by the Board of Patent Appeals and Interferences in Ex parte Allen, ___ USPQ ___ (Bd. App. & Int. April 3, 1987), held that claimed polyploid oysters are nonnaturally occurring manufactures or compositions of matter within the meaning of 35 U.S.C. 101. The Board relied upon the opinion of the Supreme Court in Diamond v. Chakrabarty, 447 U.S. 303, 206 USPQ 193 (1980) as it had done in Ex parte Hibberd, 227 USPQ 443 (Bd. App. & Int., 1985), as controlling authority that Congress intended statutory subject matter to "include anything under the sun that is made by man." The Patent and Trademark Office now considers nonnaturally occurring non-human multicellular living organisms, including animals, to be patentable subject matter within the scope of 35 U.S.C. 101.

The Board's decision does not affect the principle and practice that products found in nature will not be considered to be patentable subject matter under 35 U.S.C. 101 and/or 102. An article of manufacture or composition of matter occurring in nature will not be considered patentable unless given a new form, quality, properties or combination not present in the original article existing in nature in accordance with existing law. See e.g. Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 76 USPQ 280 (1948); American Fruit Growers v. Brogdex, 283 U.S. 1, 8 USPQ 131 (1931); Ex parte Grayson, 51 USPQ 413 (Bd. App. 1941).

A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. Accordingly, it is suggested that any claim directed to a non-plant multicellular organism which would include a human being within its scope include the limitation "non-human" to avoid this ground of rejection. The use of a negative limitation to define the metes and bounds of the claimed subject matter is a permissible form of expression. In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Accordingly, the Patent and Trademark Office is now examining claims directed to multicellular living organisms, including animals. To the extent that the claimed subject matter is directed to a non-human "nonnaturally occurring manufacture or composition of matter - a product of human ingenuity" (Diamond v. Chakrabarty), such claims will not be rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter.

Date

4-7-87

Donald J. Quigg

Assistant Secretary and Commissioner
of Patents and Trademarks